

**REMARKS**

Claims 51, 54, 81 and 82 remain under consideration in the application.  
Favorable reconsideration of the application is respectfully requested.

***I. REJECTION OF CLAIMS 51, 54, 81 and 82 UNDER 35 USC §103(a)***

Claim 51 is rejected under 35 USC §103(a) based on *Kubo et al. (JP11-101992)* or *Motomura et al. (US6646702)*, in view of *Hasegawa et al.* and *Eichenlaub*. Claims 54 and 81-82 are rejected under 35 USC §103(a) based on *Kubo et al. (JP '992)* or *Motomura et al. (US '702)*, in view of *Hasegawa et al.* and *Eichenlaub*, and further in view of *Handschy et al.* Applicants respectfully request withdrawal of each of these rejections for at least the following reasons.

Specifically, applicants respectfully submit that neither *Kubo et al. (JP '992)* nor *Motomura et al. (US '702)* is a valid reference upon which the rejection may be based.

***Kubo et al. (JP '992) Publication Date:*** April 13, 1999

***Motomura et al. (US '702) §102(e) Date:*** March 28, 2000

***Earliest Effective Filing Date (Present Application):*** September 2, 1998

The present application has an earliest effective filing date of September 2, 1998, which predates the publication/§102(e) date of *Kubo et al. (JP '992)* and *Motomura et al. (US '702)*. Thus, neither reference is valid as a basis for rejection of the claims.

In their previous response, applicants argued that *Kubo et al. (US '109)* and *Motomura et al. (US '702)* were not prior art. (see, e.g., Response filed 10/19/07; incorporated herein by reference).

Responsive to applicants' arguments, the Examiner cites MPEP §706.02(a)(II) entitled, "Determining Whether to Apply 35 U.S.C. §102(a), (b), or (e)". The Examiner

indicates that since the present application is based on a PCT application filed September 22, 1999, which is prior to November 29, 2000, applicants may not use the PCT application to reach back to an earlier filing date of September 22, 1999 through a priority or benefit claim for prior art purposes under 35 U.S.C. §102(e).

Applicants believe the Examiner may have misinterpreted the rules in this regard. MPEP §706.02(a) deals with whether an international application may be used as a reference under 35 U.S.C. §102(e) as prior art against the applicant in the present application. MPEP §706.02(a) does not relate to whether the present application is entitled a priority date back to the international filing date of September 22, 1999. Applicants respectfully ask that the Examiner reconsider the applicability of MPEP §706.02(a) in such regard.

The present application is a 371(c) of PCT application PCT/JP99/05210 filed on September 22, 1999. Under 35 USC §365(a), the filing of a PCT application designating the US is entitled to a priority date as of the filing date of the PCT application. Thus, based on the PCT application the present invention is entitled to a priority date of September 22, 1999. Again, applicants respectfully submit that MPEP§706.02(a) does not apply to determining the priority date of the present application, but rather applies to whether another PCT application is a prior art reference against the present application.

Based on the PCT based priority date of September 22, 1999, the present application predates the March 28, 2000 filing date of Motomura *et al.* (US '702) Accordingly, applicants respectfully submit that *Motomura et al.* (US '702) is not a valid reference against the present application.

Applicants further note that the present application and corresponding PCT application claim priority under 35 USC §119 to UK Patent Application No. 9820516.4, filed on September 22, 1998. A copy of the priority document has been received by the USPTO as noted in the Notice of Acceptance of Application Form PCT/DO/EO/903 mailed in July 2001. Accordingly, applicants have perfected their claim for priority based on UK Application No. 9820516.4 back to September 22, 1998.

*Kubo et al. (JP '992)* was published on April 13, 1999, which is *after* applicants' priority date of September 22, 1998 based on the UK application. Thus, *Kubo et al. (JP '992)* also is not a valid reference against the present invention.

Since neither *Kubo et al. (JP '992)* nor *Motomura et al. (US '702)* is a valid reference against the present application, each of the rejections has insufficient basis under 35 USC §103(a). Withdrawal of each of the rejections is respectfully requested.

## **II. CONCLUSION**

Accordingly, all claims are believed to be allowable and the application is believed to be in condition for allowance. A prompt action to such end is earnestly solicited.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should a petition for an extension of time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary), petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988.

Respectfully submitted,

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